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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,702	09/13/2006	Richard Martin	05-1128-A1	2568
63572 7590 08/31/2011 MCDONNELL BOEHNEN HULBERT @ BERGHOFF LLP 300 SOUTH WACKER DRIVE SUITE 3100 CHICAGO, IL 60606			EXAMINER COLEMAN, BRENDA LIBBY	
			ART UNIT 1624	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of: :
Martin et al. :
Serial No.: 10/565,702 : PETITION DECISION
Filed: September 13, 2006 :
Attorney Docket No.: 05-1128-A1 :

This is in response to the petition under 37 CFR § 1.181, filed July 19, 2011, requesting that the finality of the Office action of May 19, 2011 be withdrawn.

BACKGROUND

Only the Office action(s) pertinent to the petition will be discussed herein.

The examiner mailed a final Office action on September 30, 2010 setting a three month statutory limit for reply. At the time of this final Office action, claims 1-46 and 48 were pending. The examiner rejected claims 1-5, 32-42, 44, 46, and 48 and objected to claims 43 and 45. Claims 1-5, 32, 33, 34-42, 44, 46 and 48 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 34-42, 44 and 48 were rejected under 35 U.S.C. § 112, first paragraph, as being non-enabling.

In response thereto, applicants submitted an amendment after final and remarks on November 24, 2010 addressing the rejections set forth in the Office action of September 30, 2010.

On December 2, 2010, the examiner mailed to applicants an advisory action indicating that the after final amendment would not be entered because the amendments raised new issues that would require further consideration and/or search.

In response thereto, applicants filed a petition on December 10, 2010, requesting that the finality of the Office action of September 30, 2010 be withdrawn.

A petition decision was rendered on January 18, 2011 granting the decision to withdraw finality.

The examiner mailed a final Office action on May 19, 2011, setting a three month statutory limit for reply. At the time of this final Office action, claims 1-46 and 48 were pending. The examiner rejected claims 1-8, 10-17, 19-22, 24-28, 30-42, 44, 46, and 48 and objected to claims 9, 18, 23, 29, 43 and 45. Claims 1-8, 10-17, 19-22, 24-28, 30-42, 44, 46 and 48 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-6, 14-17, 19-22, 24-28, 30, 32, 33, 46 and 48 were rejected under 35 U.S.C. § 112, first paragraph, as being non-enabling. Claim 1 was rejected under 35 US 102(b) as anticipated by Janssen et al.

In response thereto, applicants filed a petition on July 19, 2011, requesting that the finality of the Office action of May 19, 2011 be withdrawn.

On July 19, 2011, an amendment after final and remarks were also filed addressing the rejections set forth in the final Office action of May 19, 2011.

On July 26, 2011, the examiner mailed to applicants an advisory action indicating that the after final amendment would not be entered because the amendments raised new issues that would require further consideration and/or search.

On July 29, 2011, a second amendment after final and remarks were filed addressing the rejections set forth in the final Office action of May 19, 2011.

On August 9, 2011, the examiner mailed to applicants a second advisory action indicating that the after final amendment would not be entered because the amendments raised new issues that would require further consideration and/or search.

DISCUSSION

The petition of July 19, 2011 and the file history have been carefully considered.

In the petition filed by applicants on July 19, 2011, applicants submit "that, according to MPEP § 706.07(a), a second or a subsequent action on the merits cannot be made final if it includes a new ground of rejection (for example, a rejection based on newly cited art) that is necessitated neither by Applicant's amendment of the claims nor by information submitted in an IDS. In the currently pending final Office Action the Office issued two rejections on new grounds, neither of which were necessitated by the Applicant's claim amendments. In particular, the Office issued a new rejection under 35 USC § 102 citing new prior art (Janssen *et al.*). In fact, this is the first prior art rejection that has been issued in this application. This art was not cited in an IDS, nor was it necessitated by the previous amendments. And, furthermore, it in fact does not anticipate

the claims as explained in the concurrently-filed response. The Office also issued a rejection under 35 USC § 112, first paragraph, raising issues that were not previously raised. Previously, the Office rejected claims 1-5 and 32-48 for lack of enablement for the terms "solvates", "polymorphs", and "prodrug", and claims 32-42, 44, and 48, for lack of enablement for the terms "esters", "enol ethers", etc. In response to these rejections, Applicants amended the claims to remove these terms resulting in the claims with reduced scope. In this Action, the Office issued a new enablement rejection based on the definitions of X, Y, Z, R¹, etc. This enablement rejection was not previously raised and not necessitated by the claim amendments as the same definitions of X, Y, Z, R¹, etc., as presently pending were previously pending. In view of both newly cited § 102 art and new grounds of rejections under 35 USC § 112, Applicants respectfully request that the finality of the pending Action be withdrawn. Applicants simultaneously submit herewith a petition to the technology center Director for withdrawal of the finality of this action."

Applicants' points are well-taken and found persuasive. Accordingly, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims as in the instant case nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c).

DECISION

The petition is **GRANTED**.

The final Office action mailed May 19, 2011 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. The after final amendments of July 19, 2011 and July 29, 2011 will also be entered. This application will be forwarded to the examiner to take an action consistent with the decision herein.

DECISION

The petition is **GRANTED**.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Remy Yucel
Director, Technology Center 1600